

REMARKS

Applicants respectfully request reconsideration of the above-captioned application. Minor changes have been made to claims 29 and 34.

The non-final Office Action of November 21, 2002 indicates prosecution was reopened upon further review of the Declaration and prosecution history of the original patent application. Applicants respectfully submit that the application is in condition for reissuance for at least the reasons given below.

The Office Action suggests that the Reissue Declaration is defective under 35 C.F.R. § 1.175(a)(1) because it fails to state an error relied upon for reissue insofar as the alleged error of the "light blocking aspect of the second region" is not found in the patent claims. It is believed that the Examiner is suggesting that the exact claim language be utilized in the Declaration. While it is not clear whether 37 C.F.R. § 1.175(a)(1) requires exact correspondence between the claims and the reissue declaration, a freshly executed Supplemental Reissue Declaration is filed concurrently herewith which states that "The issued claims claim less than patentee had a right to claim in reciting in the only independent claim that the light controlling means provides a light path of the lens for 'preventing light in an intermediate axial region of said light path from reaching said focal zone', rather than positive recitation that a 'near region focuses light in said light path on the information bearing level regardless of which of said at least two types of optical memory disks'." Additionally, the freshly executed Supplemental Reissue Declaration states "Every error in the patent which was corrected by the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any

deceptive intention on the part of the applicant," in accordance with MPEP § 1414.01.

This supplemental statement is made because a minor improvement is proposed to reissue claims 29 and 34, for the reasons explained below.

In light of the foregoing, withdrawal of the rejection to the declaration is respectfully requested. Should the Examiner continue the objection, a more thorough explanation as to the basis thereof is respectfully requested.

The Office Action also includes a rejection of claims 1-40 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. This rejection is believed to have been overcome for the reasons given above.

The Office Action also includes a rejection of newly presented claims 27-40 under 35 U.S.C. § 251 as allegedly being improperly broadened in a reissue application.¹ This rejection is respectfully traversed.

As the Examiner correctly notes, the language added to claim 1 in light of a prior art rejection (i.e., "without imposing a relative phase change between light and said near and far regions") has been omitted from the newly presented claims. It is respectfully submitted that the Office is incorrect, however, as to its conclusion that this change represents "recapture" of the subject matter given up during the prosecution of the original patent.

A case on point is B. E. Meyers & Co. v. United States, 56 USPQ2d 1110 (Ct. Cl. 2000) (copy enclosed) which indicates that the recapture doctrine does not apply where in

¹ Applicant does not understand the distinction in this context as the reissue application made and sworn by an assignee as opposed to a patentee. Should this distinction have bearing on the Examiner's position, and the rejections continued, an explanation would be appreciated.

fact the newly presented claims are drawn to a "separate invention eligible for patent protection, independent of whatever [element that was amended during the prosecution of the application] might be used in combination with the [newly presented subject matter].

Id. at 1116. Specifically, to quote the Meyers case in relevant part:

During the course of prosecuting its reissue claims, plaintiff contended, and the PTO examiner ultimately agreed, that a lens apparatus that produced a beam with a well-defined peripheral edge was in fact a separate invention eligible for patent protection, independent of whatever type of pulsing circuitry might be used in combination with the lens system in any particular device. In order to receive protection for this aspect of its invention, plaintiff had to delete any reference to pulsing circuitry in the reissue claims. Of course, in doing so, plaintiff deleted the specific pulsing diode and substantial pulsing current limitations that had been added to its original claim to distinguish the prior art. (Emphasis omitted.)

With respect to the claims presented in the reissue application, it is noted that original independent claim 1 is claim drafted in means-plus-function format in accordance with 35 U.S.C. § 112, sixth paragraph, and highlights that the claimed "lens controlling means" provides two aspects, one of them being "preventing light in an intermediate axial region of said light path from reaching the focal zone" and that it permits "light in said near and far regions of the light path to reach the focal zone without imposing relative phase change between light and said near and far regions."

In marked contrast, claim 27 includes positive recitations directed particularly to the aspect of the lens having "a near axial region which includes the center of the light path" wherein the "near region focuses light in said light path on the information bearing level regardless of which of said at least two types of optical disks." This aspect of the claims is also found in claim 30, which is directed to an optical pickup device with various elements

including the lens recited in claim 27. Similarly, claim 32 recites a lens device which includes a lens controller with these features. Claim 37 also recites an optical pickup device, which includes among other elements, the light controller as recited in claim 32. Hence, all of these pending independent claims are directed to a separate invention eligible for patent protection independent of the amendatory aspects of the claims appearing in the original patent.

In conclusion, it is noted that during the prosecution the Examiner has already passed on the patentability these claims over prior art. If recapture were actually effectuated by the deletion of all of the originally added aspects of the invention, presumably the same rejections imposed in the prosecution of the original patent application would have applied. Instead, it is apparent that the Examiner has already determined that the claims presented in the reissue application define a separate invention eligible for patent protection and, therefore, is respectfully submitted to not be subject to the "recapture rule" under the present circumstances.

In light of the foregoing, Applicants respectfully request reconsideration and allowance of the above-captioned application so that it may pass to reissuance.

Respectfully submitted,

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Attachment to Amendment and Reply to Non-Final Office Action

Marked-up of Claims 29 and 34

29. (Amended) A lens device as claimed in claim 27, wherein said lens scatters, diffracts, absorbs, reflects or diverts light in said intermediate axial region away from said light path.

34. (Amended) A lens device as claimed in claim 32, wherein said light controller scatters, diffracts, absorbs, reflects or diverts light in said intermediate axial region away from said light path.